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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,554	01/18/2001	Juan Carlos Parodi	BSI-320US1	1961

7590 06/24/2003  
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EXAMINER

MILLER, CHERYL L

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/764,554

Applicant(s)

PARODI, JUAN CARLOS

Examiner

Cheryl Miller

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003 and 07 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Response to Arguments***

Applicant's arguments filed March 3, 2003 have been fully considered but they are not persuasive. Even though Martin and Kugler do not recite disclose specific relative diameters along the length of the endoluminal device, diameters relative to the size of the lumens and transitional areas concave in shape, it is clear from the figures that the diameter changes from a first to a second to a third diameter and is sized relative to the lumen as claimed. It is also clear from the drawings that a transitional area from a second to a third diameter is flared outward, and the flared portion will inherently curve outward, thus be concave. Therefore, the invention of Martin and Kugler would function similar to the claimed invention.

***Claim Rejections - 35 USC § 101***

Claims 7, 9, 13, and 16 are directed toward non-statutory subject matter. The claims positively recite portions of the body (restricted section inner diameter, branch lumen inner diameter), which is non-statutory subject matter and should be corrected.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 7-16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kugler et al. (USPN 6,129,756, cited in previous office action). Kugler discloses an endoluminal device and method of treating a lumen (col.2, lines 30-45) substantially as claimed. See figure 2 and respective portions of the specification. Kugler discloses a proximal main tubular portion (10) having a first diameter, two tubular limbs (20), (30), having a second diameter, wherein the distal ends of the limbs (near (22) and (32)) have a third diameter that is cylindrical and larger than the second diameter (col.5, lines 25-31; col.9, lines 8-17; col.10, lines 26-42). Kugler has shown in Fig.2, a flared transition from the second diameter to the third diameter (col.9, lines 8-17). Because the point of inflection will not be an exact 90°, the flared transition is inherently curved, thus concave and trumpet shaped.

In the alternative, Kugler has shown in Fig.2, a flared transition from the second diameter to the third diameter (col.9, lines 8-17) that appears the same as the transition portion shown by the applicant in figure 5. Since the applicant teaches use of flared transitional portions of endoluminal devices for the purpose of anchoring, flared being either conical (fig.5) or concave trumpet-shaped (fig.4) and the applicant has not disclosed an advantage for a concave flare verses a conical flare, it would have been an obvious matter of design choice to have a concave transitional portion, which would perform equally as well as the conical transitional portion.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (USPN 5,575,817, cited in applicant's IDS) in view of Strecker (USPN 5,405,378). Martin discloses an endoluminal device and method for treating a lumen (col.1, lines 35-41; col.4, 1-35) substantially as claimed. See figures 1, 4 and respective portions of the specification. Martin discloses a proximal main tubular portion (6) having a first diameter, two tubular limbs (4), (2), having a second diameter, wherein the distal ends of the limbs have a third diameter larger than the second diameter (area near (12)). Martin has shown in fig.1 and 4 a transition portion from a tubular limb to a distal end having an increase in diameter, however does not specify the transitional portion to be concave or trumpet shaped. Strecker teaches in the same field of endoluminal devices, the use of trumpet-shaped ends on device used near branch vessels, for the purpose of preventing slippage near the branch, thus anchoring the device in place (col.6, lines 1-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Martin's endoluminal device with Strecker's teaching of trumpet-shaped ends on endoluminal device's in order to prevent slippage of the device near the branch vessel, thus anchor the device in place.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

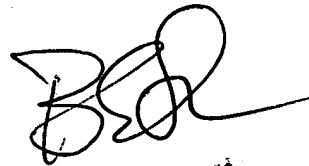
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Cheryl Miller

June 19, 2003



BRUCE SNOW  
PRIMARY EXAMINER